



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/672,852 | 09/26/2003 | Jeyhan Karaoguz | 15012US02 | 1267 |

23446 7590 09/22/2006

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

| |
|----------|
| EXAMINER |
|----------|

SHAH, AMEE A

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3625

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,852

Applicant(s)

KARAOGUZ ET AL.

Examiner

Amea A. Shah

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-57 are pending in this action.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 31, 2006, has been entered.

Response to Amendment

Applicant's amendment, filed July 31, 2006, has been entered. Claims 1 and 15 have been amended. Claims 28-57 have been added.

The amendment filed July 31, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the limitations of independent claims 1, 15, 30 and 46 regarding a user predefined association of the first user to the second user of the media exchange network.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-57 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claims 1, 15, 30 and 46 contain the added limitation of responding by employing a user predefined association of the first user to a second user. The Examiner found no support in the specification that would enable one skilled in the art as to what or how the software responds by employing a user predefined association of the first user to the second user. Because claims 2-14, 16-29, 21-45 and 46-57 are dependencies of claims 1, 15, 30 and 46, they inherit the same deficiencies and are rejected on the same bases.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claims 1, 15, 30 and 46 contain the limitation of responding by employing a user predefined association of the first user to a second user. It is unclear to one of

Art Unit: 3625

ordinary skill in the art what is meant by “a user predefined association of the first user to the second user,” and the Examiner found no description or explanation in the Specification. For example, “association” is commonly defined as “the act [or state] of association [i.e. to join as partner, friend; to keep company with; to bring together or into relationship in any of various intangible ways];” as “something linked in memory or imagination with a thing or person,” and as “the process of forming mental connections or bonds between sensations, ideas or memories” (Merriam Webster’s Collegiate Dictionary - 10th ed., 1997, page 70). The association between the first user and second user could be an account, a membership, a license or any other type of permission, a “buddy”, etc. For purposes of this action only, the Examiner interprets the association to be a license/permission. Because claims 2-14, 16-29, 21-45 and 46-57 are dependencies of claims 1, 15, 30 and 46, they inherit the same deficiencies, are rejected on the same bases, and are interpreted in the same manner.

Examiner Note

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 10, 11, 15-21, and 24 are rejected under 35 U.S.C. §102(e) as being anticipated by Novak (US 2003/0097655 A1).

Regarding claims 1, 15, 30 and 46 - Novak discloses a system (see Fig. 1) providing support for user transaction on a media exchange network (§0002).

The system comprises a television display (104) for consumption of media (§0082); a storage (310) for storing media (§0077), and having an associated network address (§0049); set top box (see Fig. 3: 102) circuitry (308) communicatively coupled to deliver media from the storage to the television display (§0076); an interface device (305) for receiving from an authorization device (see Fig. 4: 410) associated with a user, information for authorizing a user transaction, the interface device communicatively coupled to the set top box circuitry (§0074).

Novak further discloses (see Fig. 4) that the system comprises server software that receives a request (409) from a first user of the media exchange network, the request comprising at least one of the associated network address, information identifying the user transaction, and at least a portion of the information for authorizing a user transaction (§§0049, 0088, and 0112 – note that the identification credentials may be encapsulated within the request), and that responds

Art Unit: 3625

by employing a user predefined association of the first user to the send user of the media exchange network to enable the completion of the identified user transaction with the second user, via a communication network, without divulging the identity of the first user (§§0030, 0090, 0093, 0094, 0096, 0098, 0099, 0103, 0106-0109, and 0120-0124). For example, the Examiner notes (with reference to Fig. 4) an embodiment in which the verification of identity credentials includes checking the identity credentials with a trusted third party (TTP) (§0090). A license key (412) and an access key (414) is all that is needed to decrypt the digital content (§§0096 and 0098). These keys are received by the set top box (see Fig. 4 and §0030). The set top box receives the digital content (404) from a content source (420). The user may obtain access to digital content based on the user's license (411) stored at the verification entity (406: in this case the trusted third party). The license (411) is not tied to the user's set top box. The user may view the program using another set top box by simply inserting his or her smart card (410) and/or providing the necessary pass code, pass phrase, biometric data or the like (§0103). In this manner the transaction is enabled without divulging the identity of the user to a vendor (either the broadcast center (110) or the sources (420) (§0099). Furthermore, the first user can transfer all or a portion of the license to a second user (§§0120-0124).

Regarding claims 2 and 16 - Novak discloses that the media comprises at least one of audio, a still image, video, real-time video, and data (§0082).

Regarding claims 3 and 17 - Novak discloses that consumption comprises at least one of playing audio, displaying a still image, displaying video, and displaying data (§0082).

Art Unit: 3625

Regarding claim 4 - Novak discloses that the associated network address is one of an Internet protocol (IP) address, a media access control (MAC) address, and an electronic serial number (ESN) (§0049).

Regarding claims 5 and 18 - Novak discloses that the communication network comprises at least one of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and a wireless infrastructure (§§0052, 0053, and 0085).

Regarding claims 6 and 19 - Novak discloses that the communication network is the Internet (§§0057, 0060, 0084, 0085, and 0098).

Regarding claims 7 and 21 - Novak discloses that the interface device comprises one of an optical card reader, a magnetic card reader, a radio frequency identification (RFID) interface, an integrated circuit (IC) card interface, a biometric sensing device, and a cellular telephone (§0074).

Regarding claims 10 and 20 - Novak discloses that the user transaction comprises at least one of the storage, exchange, purchase, and consumption of media (§0082).

Regarding claims 11 and 24 - Novak discloses that the system further comprises a remote control communicatively coupled to the set top box (§0050).

Art Unit: 3625

Regarding claims 28 and 29 – Novak discloses that the user transaction comprises the purchase of one or more of a good and a service (§§0082 and 01201 – note the good or service is the viewing or listening to a specific program and/or a license for the program)

Regarding claims 30-35, 38-40, 44-49, 55 and 57 - All of the limitations in claims 30-35, 38-40, 44-49, 55 and 57 are closely parallel to the limitations of claims 1-7, 10, 11, 15-21, and 24, analyzed above and are rejected on the same bases.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9, 12-14, 22, 23, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak (US 2003/0097655 A1) in view of Russell et al. (US 2004/0044627 A1).

Regarding claims 8, 9, 22, and 23 - As noted above, Novak discloses an interface device communicatively coupled to the set top box circuitry (see Fig. 4). Novak is silent as to the coupling mechanism being wired or wireless.

The Examiner notes, however, that Novak teaches that the authentication process may require the user (402) to enter additional information via the remote control (106). Such remote control may use infrared (IR), radio frequency (RF), or other wireless technologies to transmit control signals to the set top box (102) (§0050). It is also noted that Novak teaches that the user may need to have current biometric data scanned by a biometric reading device, such as a fingerprint or retinal scanner, which is also sent with or following the request (409) for verification purposes (§0089). Novak does not teach, however, that the biometric reading device is either integral with the remote control or that the reading device is wirelessly coupled to the set top box circuitry.

Regarding claims 12 and 25 - The Examiner notes that Novak teaches that the authentication process may require the user (402) to enter additional information via the remote control (106) which communicates the user transaction authorization information to the set top box circuitry (§0089). Novak, however, does not teach that such authorization information is from an authorization device, per se. It is also noted that Novak teaches that the user may need to have current biometric data scanned by a biometric reading device, such as a fingerprint or retinal scanner, which is also sent with or following the request (409) for verification purposes (§0089). Novak does not teach, however, that the remote control comprises the biometric reading device.

Regarding claims 13, 14, 26, and 27 - The Examiner notes that Novak does not teach that the remote control comprises a scanning device to identify at least one of a product and a service.

However, Russell et al. discloses a similar system providing support for user transaction on a media exchange network (*see, e.g.*, Abstract).

Russell et al. discloses a remote control in the form of a personal identifying device (PID) which is a portable device (§0182) which is used to control access (§0060) to entertainment systems (§0202) in conjunction with applications exemplified by proprietary content browsing (including pay television, pay audio, pay entertainment, royalty-based offerings such as ASCAP or other proprietary music offerings)(§0220).

Regarding claims 8, 9, 22, and 23 - Russell et al. teaches that the PID comprises a wireless coupling mechanism which comprises at least one of an infrared link (IR) and a radio frequency (RF) link (§0170). Russell et al. teaches that the PID may comprise both wired and wireless alternatives (§0171).

Regarding claims 12 and 25 - Russell et al. teaches that the PID comprise an interface device for receiving user transaction authorization information from an authorization device associated with a user (§0184).

Regarding claims 13, 14, 26, and 27 - Russell et al. teaches that the PID comprises a scanning device to identify at least one of a product and a service. The scanning device comprises one of an optical scanner and a radio frequency identification (RFID) interface (§0299).

It would have been obvious to one of ordinary skill in the art to have modified the system of Novak to have included a remote control of the type and functionality taught by Russell et al. (thereby integrating the smart card reader of Novak in the disclosed remote control of Novak) in order to have provided a self contained, and portable remote control that can be carried on one's person (see Russell et al., ¶0182). Such self contained portability would have been especially advantageous and desirable in the scenario taught by Novak in which a person wishes to access digital content while away from their usual access location (see Novak, ¶0103). In this scenario, it would not be necessary that the access location located away from their usual access location have an interface device associated with the access location because it would have been advantageously integrated into the portable remote control carried by the person.

Regarding claims 36, 37, 41-43 and 56 - All of the limitations in claims 36, 37, 41-43 and 56 are closely parallel to the limitations of claims 8, 9, 12-14, 22, 23 and 25-27, analyzed above and are rejected on the same bases.

Claims 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak (US 2003/0097655 A1) in view of *In re Japikse*, 181 F.2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950).

Regarding claims 50-55 – The Examiner notes that Novak discloses that the entities of the system may be separate and distinct, or combined in various ways, but does not specifically disclose wherein the server and/or storage is located within the communication terminal at the first location, or wherein the server and/or storage is located at a third location remote from the

Art Unit: 3625

first and second locations. However, *In re Japikse* states there is no new invention in shifting the location of parts of an invention if the operation of the device would not be modified. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the location of the server and/or storage because such modifications have been well within the level of skill in the art (as noticed by the Court in *Japikse*) and would not have otherwise affected the operations of the server and/or storage.

Response to Arguments

Applicant's arguments filed July 31, 2006, have been fully considered but they are not persuasive. In response to applicant's argument that the prior art Novak fails to teach, suggest or disclose newly added limitation in claim 1 of server software that receives a request from a first user of the media exchange network, the request comprising at least one of the associated network address, information identifying the user transaction, and at least a portion of the information for authorizing a user transaction (Remarks, page 14), the examiner disagrees. Novak does disclose this server software that receives a request with the request comprising identifying information. Novak states, "[t]he identification credentials along with an indication of the desired digital content may be encapsulated within a request, which is sent to the verification entity via the network connections" (page 6, ¶0088) and further "the request may include a persona network address (e.g. ENUM address), user identifier, or e-mail address unique to the user, as well as a serial number or title of a particular program of digital content" (page 8, ¶0112). The information identifying the user transaction comprises the identification details and indication of desired digital content, and this information is included in the request.

Applicant argues that Novak fails to teach, suggest or disclose newly added limitation of claims 1, 15 30 and 46 of server software that response by employing a user predefined association of the first user to a second user of the media exchange network to enable the completion of the identified user transaction with the second user, without divulging the identity to the first user and in particular, that Novak divulges the identity because it is handed to the verification entity, and that Novak does disclose user predefined association of first and second users (Remarks, pages 14-15). The examiner disagrees.

With regards to not divulging the identity of the first user, as stated in the previous office action and supra, Novak discloses an embodiment wherein the identity of the first user is not divulged wherein the verification of identity credentials includes checking the identity credentials with a trusted third party (TTP). A license key and an access key, which are received by the set top box, decrypt the digital content. The set top box receives the digital content from a content source. The user may obtain access to digital content based on the user's license stored at the verification entity (in this case the trusted third party). The license (411) is not tied to the user's set top box. The user may view the program using another set top box by simply inserting his or her smart card and/or providing the necessary pass code, pass phrase, biometric data or the like. The first user may also transfer all or part of this license to a second user. In this manner the transaction is enabled without divulging the identity of the first user.

With regards to employing an association, as discussed supra, Novak further discloses employing a user predefined association of the first user to the second user, as noted above, wherein the association is of permission, the first user gives permission, i.e. transfers all or part

Art Unit: 3625

of a license, to the second user, and the software employs this association to complete the transaction.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ameer A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

September 15, 2006


JEFFREY A. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600